



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,960	11/27/2001	Koji Tokunaga	15124	1702

23389 7590 06/22/2004

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER

WEAVER, SCOTT LOUIS

ART UNIT	PAPER NUMBER
----------	--------------

2645

17

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,960

Applicant(s)

TOKUNAGA, KOJI

Examiner

Scott L. Weaver

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 14.16.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

2. The drawings are objected to because figure 1 is not labeled Prior Art as describe in the disclosure. Further, figure 2 does not show the two memory areas in a single memory device as claimed. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 2645

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Qua et al.

(#6,222,909)

The claims read on Qua as follows: Qua teaches as pertains to claim 1,
A portable phone having a recording function for recording audio data during telephone conversation,
(see abstract; figure 1; col.1,ln.39-44; col.3,ln.22-27 which teaches a wireless phone)

said portable phone comprising: a plurality of memories, each [memory] for endless recording, as a conversation content, the audio data during the telephone conversation;

(in accordance with claim 2 limitations, the 2 memories are considered merely different memory areas of a single memory device. Qua teaches a single device by reference to the detachable storage unit 120 for example. Further, Qua teaches to be able to mark each of the portions of a conversation for later retrieval. The marking of a recorded audio data is considered to record the data in a different memory area in the single memory, as upon retrieval, that specific portion of memory would be accessed to retrieve the data in that location., col.3,ln.22-29 col.3,ln.44-47; col.5,ln.3-7; col.5,ln.25-31; col.5,ln.36-39)

a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the

Art Unit: 2645

audio data instead of said first memory which endless-records, as the conversation content, the audio data until then;

(Qua teaches the user enable to mark the audio data by initiating recording as noted above via col.5,ln.36-39, the marking is indicating the different memory area for use in later retrieval, and as the marking is enabled by a user input such is considered a switch as claimed herein as an activation sequence from the user is done via keypad, figure 2, 202-220)

*and
a reproducing unit for reproducing the conversation content which said first memory endless-records before being switched by said switching unit.*

(Qua teaches the retrieval of audio notes via identification code, identifying the memory area of the stored note for retrieval col.6,ln.26-39 with use of similar types of control as for the recording as well as for replay (reproduction) col.6,ln.51-54 and thus each and every part of a sequence of notes including the one that was recorded in the first memory area can be reproduced)

As pertains to claim 2, Qua teaches
the memories are constituted by a plurality of memory areas of a single memory device, (storage unit 120) as was noted above, each of the memory areas being capable of individually endless-recording the audio data.

(in as far as 'endless-recording' is understood and defined by the disclosure, Qua teaches recording audio until the user or call is ended, each memory of the plural memory areas can contain the whole note or different memory areas can hold different portions of the audio note depending on the manner in which the user marks the audio note via the 'switching')

As pertains to claim 3, Qua teaches a key for operating said reproducing unit to reproduce the audio data; said reproducing unit successively reproducing the conversation contents in the order of recording in which said memories records the conversation contents.

(Qua teaches implantation of the various functions via keypad input col.6,ln.59-col.7,ln.12)

Art Unit: 2645

Conclusion


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Previously cited reference Kozo EP 0 920 171 A2 teaches use of encoder/decoder which stores data temporarily before sending to a memory 16 via col.5-6, encoder/decoder as well as latches and shift registers are considered memory.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 703-308-6974. The examiner can normally be reached on Tuesday to Friday 8 AM to 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645